

Paper No. 14
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wagner Spray Tech Corporation

Serial No. 75/237,611

Stephen C. Lee of Faegre & Benson for applicant.

Andrew P. Baxley, Trademark Examining Attorney, Law Office
114 (Mary Frances Bruce, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Wagner Spray Tech
Corporation to register the mark shown below

for "electric powered chain saws, electric powered limb trimmers, electric powered sharpeners for chain saws, and parts thereof."¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the following previously registered marks that confusion is likely. All are concurrent use registrations, with each registrant claiming the other two as exceptions to its right to exclusive use. The cited registered marks are: LUMBER JACK for "retail hardware store services and retail lumber yard and construction material outlet services;"² LUMBERJACK for "lumberyard, construction material outlet, and hardware store services;"³ and LUMBERJACK'S for "lumberyard, construction material outlet and hardware store services."⁴

¹ Application Serial No. 75/237,611, filed February 6, 1997, alleging first use on June 27, 1994.

² Registration No. 1,147,898, issued February 24, 1981; combined Sections 8 and 15 affidavit filed.

³ Registration No. 1,593,521, issued April 24, 1990; combined Sections 8 and 15 affidavit filed.

⁴ Registration No. 1,594,635, issued May 1, 1990; combined Sections 8 and 15 affidavit filed.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant contends, in urging that the refusals be reversed, that retail store services involve the sale of a wide variety of products, and that consumers would not believe that registrants' services and the specific lawn and garden products of applicant had a common source. Further, applicant asserts that applicant's goods are used for landscaping, not logging or construction, and that, therefore, applicant's goods are distinct from the lumber yard and construction material outlet services of registrants. Applicant also argues that the Examining Attorney's position, taken to its extreme, essentially grants to registrants "protection for almost all classes of goods and services."

The Examining Attorney maintains that the marks at issue are essentially identical and that they are applied to closely related goods and services. The Examining Attorney has relied upon a dictionary definition of the term "lumberjack,"⁵ one third-party registration and

⁵ The dictionary listing, of which we take judicial notice, defines the term as "one who fells trees and transports the timber to a mill; a logger."

excerpts retrieved from the NEXIS database which show, according to the Examining Attorney, that "applicant's goods are of a type that are sold through the registrants' services."

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Food, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

With respect to the involved marks, applicant does not dispute, with good reason, that they are essentially identical. Indeed, the marks are virtually identical in sound, appearance and meaning. Although the marks are somewhat suggestive, the marks convey the same suggestion. Notwithstanding this suggestiveness, however, applicant has not introduced evidence showing any third-party uses of the same and/or similar marks for the types of services rendered by registrants. This virtual identity among the marks makes it likely that, if the marks were used in connection with related goods and/or services, purchasers

would be confused. In this connection, the Board has stated that "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

We thus turn to focus our attention, as have applicant and the Examining Attorney, on the similarity/dissimilarity between applicant's goods and registrants' services.

With respect to the goods/services, it is clear that the Board must compare applicant's goods as set forth in its application with the services as set forth in the cited registrations. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981) It is not necessary that the goods and/or services be similar or competitive or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same person under circumstances that could, because of the similarity of the marks, give rise to the mistaken

belief that they originate from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, we find that applicant's electric power tools are sufficiently related to each of the registrants' hardware store services that, when these goods and services are marketed under virtually identical marks, consumers in the marketplace are likely to be confused. The NEXIS articles show that goods of applicant's type are sold in hardware stores. Indeed, applicant acknowledges that "some hardware stores sell chain saws and pruners." (brief, p. 4) Applicant's identification of goods is not restricted in any way, so we must assume that applicant's power tools move in all normal channels of trade, which in this case would include hardware stores. In addition, the goods and services would be offered to the same classes of consumers. In sum, we find that consumers familiar with any of the registrants' LUMBERJACK store services would be likely to believe, upon encountering applicant's LUMBERJACK power tools, that the goods and services originated with or are somehow associated with or sponsored by the same source.

Applicant's other arguments which go to the equities of the refusal are not persuasive principally for the reasons set forth by the Examining Attorney in his brief.

To the extent that any of the points raised by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals to register are affirmed.

R. F. Cissel

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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